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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,015	04/09/2001	Salim G. Kara	061135/P000C2CP1C1/101032	9558

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DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.
2200 ROSS AVENUE
SUITE 2800
DALLAS, TX 75201-2784

EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,015

Applicant(s)

KARA, SALIM G.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 120 is acknowledged.
3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).
4. Claims 1-16 are rejected under the judicially created doctrine of double patenting over claims 1-47 of U. S. Patent No. 6,233,568 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.
 - 4.1 The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:
 - A) determining transaction parameters;
 - B) using the determined parameters to rate an item to be shipped by a carrier for a plurality of carriers;
 - C) providing the rating results for comparison; and
 - D) based on the comparison picking a carrier.
 - 4.2 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29

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USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

4.3 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

4.4 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-16 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5.1 In regard to claims 1-8 & 13-15, although on of ordinary skill at the time of the invention would known how to accomplish the recited actions/functions from the language of these claims, one of ordinary skill could not determine from the language of these claims whether or not they are making and/or using the claimed invention, since from the language of these claims it is unclear:

A) in regard to claims 1-6 & 15, since these claims fail to produce/generate the recited authorization information, it is unclear how authorization information can either:

- (1) be printed (claim 1); or
- (2) stored and/or updated (claim 2); or
- (3) be used to verify payment (claim 3); or
- (4) include a graphical security indicia (claim 4), or
- (5) include a common credit value for a number of carriers (claim 5); or
- (6) include a credit value for each carrier (claim 6).

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B) in regard to claims 8, 13 & 14, since this claim fails to produce/generate the recited authorization information, it is unclear how authorization information can be printed.

5.2 Claims 1-12, 15 & 16 are inoperative and therefore lack utility for the recited purpose of the disclosed and claimed invention, since:

A) the authorization of the transaction is not generated, note above in regard to claims 1-6, 15 see above in section 5.1(A);

B) the authorization of the transaction is not generated, note above in regard to claim 8 see above in section 5.1(B);

C) the generated authorization information is not used to ship an item, it is unclear how the transaction value can be either authorized or verified, in regard to claim 9.

For as the Court has specifically pointed out, claims must recite utility for the disclosed purpose of the invention, (General Electric Co. V. U.S., 198 U.S.P.Q. 65 (U.S. Court of Claims, 1978), Hanson v. Alpine Valley Ski Area 204 U.S.P.Q. 794 (District Court, E. D. Michigan, N. Div. 1978) and Banning v. Southwestern Bell Telephone C., 182 U.S.P.Q. 683 (SD Tex, 1974)).

5.3 Claims not specifically mentioned above, inherit the defects of the base claim through dependency. For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6.1 Claims 1-4, 7, 9-12, 15 & 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Piccione (4,495,581) or Barns-Slavin et al (5,117,346) or Theil (EP 0805422 or 5,699,258 or 6,035,291 or 6,321,214) in view of Berson et al (6,039,257).

6.1.1 In regard to claims 1, 3, 7, 9 & 10, either Piccione ('581) or Barns-Slavin et al ('346) or Theil ('422 or '258 or '291 or '214), which disclose shipping systems/methods that determine the lowest cost carrier/provider for an item to be shipped. To this end, after the user has determined the appropriate shipping transaction parameters and entered the transaction parameters into the shipping system of either Piccione ('581) or Barns-Slavin et al ('346) or Theil ('422 or '258 or '291 or '214) as a request for shipping services, the operating program would control the general purpose processor of these systems to use the shipping transaction parameters to determine the value of the shipping transaction for a number of carriers and the available services provided by the carriers that would meet the user's request for shipping services. After the determined shipping transaction values for a number of carriers and the available services provided by the carriers have been determined, the shipping transaction values and an indication of the type of service are provided to the user in a sequence which starts with the lowest shipping transaction value and continues with each next higher shipping transaction value. In this manner the user may compare the shipping transaction values for each carrier and service provided by the carrier until the user selects the particular carrier and service that meets the user's shipping requirements.

6.1.2 Although these systems do not disclose printing an authorized indicia for the selected carrier in the environment of postage metering Berson et al ('257), discloses using accounting information stored in a memory attached to the general purpose processor to generate a multidimensional barcode for the validation of a postage indicia as proof that the user has paid the determined transaction value for the selected service from the selected carrier. Where the

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purpose of an indicia is to provide acceptable proof to the carrier or carriers using a verification process that the correct shipping charge has been paid by the user. Since, the carrier would want to receive appropriate compensation for the shipping services to be provided by being properly paid for services rendered to the user, it would have been obvious to one of ordinary skill at the time the invention was made that the shipping systems of either Piccione ('581) or Barns-Slavin et al ('346) or Theil ('422 or '258 or '291 or '214) could be modified to print an authorization indicia as taught by Berson et al ('257).

6.1.3 In regard to claims 2, 7, 11 & 12, it is well known to use a secure accounting unit in a shipping fee determining systems to ensure proper accounting for the actual shipping fee used. Since the shipping fee determining systems of systems of either Piccione ('581) or Barns-Slavin et al ('346) or Theil (EP '422 or '258 or '291 or '214) as modified by Berson et al ('257) are computer implemented systems using a general purpose processor based system that has been programmed to perform the tasks of determining and accounting for the dispensed shipping, it would have been obvious to one of ordinary skill at the time the invention was made that the systems of either Piccione ('581) or Barns-Slavin et al ('346) or Theil (EP '422 or '258 or '291 or '214) as modified by Berson et al ('257) would contain a secure accounting unit/memory connected to a processing unit as is well known for postage meter accounting units.

6.1.4 In regard to claim 4, since it is well known to use an indicia, which represents that proper accounting has occurred and that includes at least a town circle and a box for the shipping fee with possible a bird, note the bird symbol on a postage indicia created by PITNEY BOWES, it would have been obvious to one of ordinary skill at the time the invention was made that the systems of either Piccione ('581) or Barns-Slavin et al ('346) or Theil (EP '422 or '258 or '291 or '214) as modified by Berson et al ('257) would use an indicia that includes graphic security information.

6.1.5 It is noted that as recited in the instant claims, neither:

- A) the use of a general purpose process based system; nor
- B) a particular graphical indicia;
- C) the exact nature of the selected carrier;

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would affect the operation of the invention as claimed, therefore these features are considered to be non function descriptive material. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

6.1.6 In regard to claims 15 & 16, it is noted that the shipping parameters entered by the user would include a request for any type of special service requested by the user as well as any limitations on the shipping service requested by the user.

6.2 Claims 5 & 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Piccione (4,495,581) or Barns-Slavin et al (5,117,346) or Theil (EP 0805422 or 5,699,258 or 6,035,291 or 6,321,214) as modified by Berson et al (6,039,257) as applied to claims 1-7, 9-12, 15 & 16 above and further in view of either Vermesse (4,914,606) or Ramsden (5,233,532).

6.2.1 In regard to claims 5 & 6, neither Piccione ('581) nor Barns-Slavin et al ('346) nor Theil ('422 nor '258 nor '291 nor '214) as modified by Berson et al ('257) disclose the use of a common credit register for two or more carriers (claim 5) or an unique credit register for each carrier, however, in the environment of postage metering either Vermesse ('606) or Ramsden ('532) disclose two separate systems that accomplish the same result, that is the systems of either Vermesse ('606) or Ramsden ('532) receive payment from the user and then account for the payment to the appropriate carrier so that each carrier is appropriately compensated for the requested shipping services. That is in Vermesse ('606) a single credit register is used that

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contains a number of credit subregisters for each user/carrier, while Ramsden ('532) uses a single register and keeps an electronic log of how much is to be distributed to each carrier. Since the shipping systems of either Piccione ('581) or Barns-Slavin et al ('346) or Theil (EP '422 or '258 or '291 or '214) as modified by Berson et al ('257) dispense shipping fees for a number of different carriers, it would have been obvious to one of ordinary skill at the time the invention was made that the shipping systems of either Piccione ('581) or Barns-Slavin et al ('346) or Theil (EP '422 or '258 or '291 or '214) as modified by Berson et al ('257) could be further modified to keep appropriate track of the dispensed shipping fee allotted to each carrier so as to correct compensate the carrier for the services rendered to the user.

7. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

7.1 Claims 1-16 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

7.1 Claims 1-16 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since they fail to comply with the "requirements this title, namely 35 U.S.C. § 112 2nd paragraph and 35 U.S.C. § 103 as set forth above.

7.2 Claims 1-12, 15 & 16 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since they lack substantial and practical utility.

A) it is respectfully noted that the authorization of the transaction is not generated, note above in regard to claims 1-6, 15 see above in section 5.1(A);

B) it is respectfully noted that the authorization of the transaction is not generated, note above in regard to claim 8 see above in section 5.1(B);

C) it is respectfully noted that the generated authorization information is not used to ship an item, it is unclear how the transaction value can be either authorized or verified, in regard to claim 9.

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In view of the above, it is considered that the invention of claims 1-12, 15 & 16 lack substantial and practical utility for authorizing and verifying shipping transaction values.

8. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

A) the prior art, for example:

(1) either Piccione (4,495,581) or Barns-Slavin et al (5,117,346) or Thiel (EP 0805422 or 5,699,258 or 6,035,291 or 6,321,214), which disclose determining the lowest cost carrier for an item to be shipped based on user entered shipping transaction parameters.

(2) Berson et al (6,039,257), which discloses using accounting information to generate a multidimensional barcode for the validation of a postage indicia.

B) however, in regard to claim 8, the prior art does not teach or suggest that the shipping system may perform other functions, such as a word processor, database, spreadsheet or accounting.

C) however, in regard to claims 13 & 14, the prior art does not teach or suggest using a program/application that is not related to shipping and running on a separate general purpose processor to enter the shipping transaction parameters of the user's request.

9. Response to applicant's arguments.

9.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been overcome by applicant's last response.

9.2 As per the double patenting rejection, even though both instant applicant and the U.S. Patent 6,233,568 will expire on the same date, since:

A) both instant applicant and the U.S. Patent 6,233,568 cover overlapping subject matter; and

B) it is conceivable that during enforceable life of either patent the patents may be separately assigned to different owners;

a Terminal Disclaimer to tie the patents together must be required so that both patents will remain under common ownership. Hence, applicant's arguments are non-persuasive.

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9.2 As per the 35 U.S.C. § 103 rejection, since:

A) in regard to the claimed “general multi-purpose processor-based system”, it is respectfully noted that one of ordinary skill would readily realize that any computerized system is in fact a “general multi-purpose processor-based system” where the computerized system differs from any other computerized system only in how either what the system is programmed to do or in how the functions are performed. With this in mind, claims 1-7, 9-12, 15 & 16 clearly fail to recite that the claimed system/method performs any other function other than those related to shipping, hence one of ordinary skill would recognize the claimed system as being in fact a dedicated shipping system like the ones disclosed in the combination of either Piccione (4,495,581) or Barns-Slavin et al (5,117,346) or Theil (EP 0805422 or 5,699,258 or 6,035,291 or 6,321,214) in view of Berson et al (6,039,257). Further in this regard, it is respectfully noted that until applicant recites a specialized function or apparatus that would not be performed by a general purpose processor system with in a closed metering system, applicant’s arguments regarding the unclaimed distinctions and merits of a open verves closed postage metering system are directed to unclaimed distinctions and merits.

B) in regard to the claimed “presentation for comparison”, it is respectfully noted that the claims do not recite to whom or to what or how the values are presented, therefore one of ordinary skill would readily realize that the process of selecting the lowest transaction value for a carrier by the user would inherently require the rates for each carrier to be presented for comparison so that the lowest rate for any of the carriers may be selected, this would still be the case regardless of where the presentation and comparison took place, even if the comparison took place only with in the computer’s processor.

C) in regard to the use a secure accounting, note the preponderance of the prior art which teaches the required use of a secure accounting device, which clear would suggest to one of ordinary skill that postage metering system include a secure accounting device.

D) the standard of evidence used in reject any claim is based on the preponderance of the evidence, the any number of references could be used in evidence to show the knowledge or the level of skill that one of ordinary skill would have had at the time the invention was made. Therefore, based on the teachings of each of the cited references the knowledge of one of ordinary skill would indicated that it is well known in the environment of postage metering to:

- (1) determine the transaction parameters by entering the information required to determine the correct shipping fee;
- (2) use the entered parameters to determine the correct shipping fee for a number of different carriers/providers;
- (3) compare the determined shipping fee for each of the carriers/providers;
- (4) based on the comparison select the lowest cost carrier/provider; and
- (5) print an acceptable indication that the correct shipping fee for the selected carrier/provider has been paid.

Hence each element of the claims has been addressed as well as the motivation for a combination of references.

Therefore, in view of the above comments, applicant's argument's are deemed non persuasive.

10. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

11.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

11.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

11.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

10/31/04


Edward R. Cosimano

Primary Examiner A.U. 3629